



Dkt. 43016-C/JPW/AKC/JKM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Philip Livingston and Friedhelm Helling
U.S. Serial No.: 08/475,784 Group Unit: 1806
Filed : June 7, 1995 Examiner: A. Caputa
For : GANGLIOSIDE-KLH CONJUGATE VACCINE PLUS QS-21

#12
C. Sw
5/19/97

1185 Avenue of the Americas
New York, New York 10036
April 21, 1997

Assistant Commissioner for Patents
Washington, D.C. 20231

MAY 13 1997

GROUP 180

Sir:

COMMUNICATION IN RESPONSE TO MARCH 19, 1997 OFFICE ACTION AND
SECOND COMMUNICATION REQUESTING CORRECTION OF FILING RECEIPT

This Communication is submitted in response to the Office Action issued March 19, 1997 by the U.S. Patent and Trademark Office in connection with the above-identified application. A response to the March 19, 1997 Office Action is due April 19, 1997. However, because April 19, 1997 falls on a Saturday, a response submitted on the next business day, namely Monday, April 21, 1997, is to be considered timely under 37 C.F.R. § 1.7. Accordingly, this Communication is being timely filed.

REMARKS

Claims 1-4, 6-20 and 44-52 are pending and under examination in the subject application.

The Examiner stated that the Communication filed on December 16, 1996 is non-responsive to the prior Office action because applicants have failed to respond to the obviousness type double patenting of copending applications 08/477,147 and 08/481,809. The Examiner stated that since the response appears to be bona fide, but through an apparent oversight or inadvertence failed to provide a complete response, applicants are required to complete the response within a time limit of one month from the

date of this letter or within the time remaining in the response period of the last office action, whichever is longer. The Examiner stated that no extension of this time limit may be granted under either 37 C.F.R. 1.136 (a) or (b), but the period for response set in the last office action may be extended up to a maximum of six months.

In response, applicants respectfully traverse the Examiner's provisional obviousness-type double patenting rejection. Applicants maintain that the content of claims 1-20 and 44-52 in the subject application differ from the content of claims 44-56 in copending U.S. Serial Nos. 08/477,147 and 08/481,809. In the subject application, applicants' claims are directed to a vaccine for stimulating or enhancing in a subject to which the vaccine is administered, production of an antibody.

Applicants further point out that for a provisional double-patenting or obviousness-type double patenting rejection, M.P.E.P. §804 requires that the:

'provisional' double patenting rejection should continue to be made by the Examiner in each application as long as there are conflicting claims in more than one application unless that 'provisional' double patenting rejection is the only rejection remaining in one of the applications. If the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the Examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the 'provisional' double patenting rejection in the application(s) into a double patenting rejection at the time the one application issues as a patent.

Therefore, applicants maintain that even if the Examiner continues to conclude that the claims of the subject application conflict with the claims of U.S. Serial Nos. 08/477,147 and 08/481,809, the provisional rejection should be withdrawn in view of applicants' arguments which overcome the other rejections

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of this application under Sections 101, 103 and 112. Thus, the subject application should be allowed to issue.

In view of the foregoing statements, applicants respectfully request that the Examiner reconsider and withdraw the rejection based on provisional obviousness-type double patenting.

SECOND COMMUNICATION REQUESTING CORRECTION OF FILING RECEIPT

This Communication is filed to request a corrected Filing Receipt in connection with the above-identified application. Applicants previously filed a Communication Requesting Corrected Filing Receipt with the U.S. Patent and Trademark Office on February 23, 1996, attached hereto as **Exhibit A**. Since February 23, 1996, applicants have not received a corrected Filing Receipt reflecting the required corrections, as stated below.

Upon receipt of the official Filing Receipt for the subject application, a copy of which is attached hereto as **Exhibit B**, applicants' undersigned attorney noticed errors.

Applicants hereby respectfully request that a corrected Filing Receipt be issued. Specifically, after "CONTINUING DATA AS CLAIMED BY APPLICANT-", the following now appears:

"THIS APPLN IS A CON OF PCT/US94/00757 01/21/94
WHICH IS A CON OF 08/009,628 01/21/93 PAT 5,333,920"

A corrected Filing Receipt should read as follows:

--THIS APPLN IS A CON OF PCT/US94/00757 01/21/94
WHICH IS A CIP OF 08/009,268 01/22/93 ABN--

Applicants contend that the change to the Filing Receipt is due to a clerical error made by the PTO and that the correct continuation information of the subject application may be found in a Second Preliminary Amendment filed on November 13, 1995.

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The Second Preliminary Amendment changed page 1, line 1 of the subject application to read "This application is a continuation of PCT/US94/00757, filed January 21, 1984, which claims priority of and is a continuation-in-part of U.S. Serial No. 08/009,268, filed January 22, 1993, now abandoned." A copy of the Second Preliminary Amendment is attached hereto as **Exhibit C**. Accordingly, applicants request that a corrected Filing Receipt be issued.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Communication And Second Communication Requesting Correction Of Filing Receipt. However, if any other fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

Albert Wai Kit Chan

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Albert Wai Kit Chan 4/21/97
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